

Suggestions on New Japanese Patent Law

Effective For the Applications Filed:
On or After April 1, 2007



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1. Amendment Is More Limited, Even After First Official Action

- After the official action, the amendment can be made only within the scope of the unity of the invention of the examined claims.
- If not, the amendment constitutes a reason of rejection.



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Example

- Claims A and B lacking unity of the invention were originally presented and only claim A was examined.
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- Canceling claim A to leave claim B is not acceptable.



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Suggestion 1

- When claims A and B may not satisfy the unity of the invention...
- Present the more important claim in front.
- When the first claim group is abandoned in the US, the preliminary amendment should be filed in JP.



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2. Divisional application can be filed within 30 days from the allowance.

Note, however, that if the application was filed in Japan before April 1, 2007, divisional applications can not be filed after the allowance.



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Suggestion 2

- When an allowance is made, reconfirm that the allowed claims cover all of what the applicant wants.
- If not, a divisional application should be filed.



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3. First OA In Divisional Becomes Final If:

- (1) Parent received OA before examination is requested for divisional, and
- (2) Parent OA was not cured in divisional before the first OA in divisional.

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After Final, Amendment Must Be:

- (1) canceling claims,
- (2) limiting claims, or
- (3) correcting errors.

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Suggestion 3

- Official actions issued for the parent should be reviewed when the request for the examination is filed for the divisional.
- File the divisional and its request for the examining earlier, for the purpose of challenging a broader scope in the divisional.

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4. Longer Term to File Translation of English Application

- 14 months from the priority date.
- Request for the examination can be filed before translation.

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Suggestion 4

- If the applicant desires to obtain a patent earlier in Japan while deferring the payment of the translation fee...
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- File the application in English and request the examination at an early stage while deferring the translation.

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Thank you.

- New Law is Applied to the Applications Filed On or After April 1, 2007.
- Should you have any question, please contact us at cases_to_jp@ryuka.com.

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